

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s) : Michael John REED et al
U.S. Serial No. : 10/674,892
Filing Date : September 30, 2003
For : COMPOUND
Art Unit : 1617
Examiner : Barbara P. Badio
Confirmation No. : 4836

745 Fifth Avenue, New York, NY 10151
EXPEDITED PROCEDURE
RESPONSE AFTER FINAL ACTION
UNDER 37 CFR 1.116

FILED VIA EFS-WEB
ON OCTOBER 3, 2007

**PETITION FOR WITHDRAWAL OF FINALITY,
WITHDRAWAL OF JULY 3, 2007 OFFICE ACTION,
AN INTERVIEW WITH THE EXAMINER
PRIOR TO ISSUANCE OF ANY FURTHER OFFICE ACTION
&
IF AGREEMENT ON ALLOWANCE NOT REACHED THEN FOR ISSUANCE OF ALL
FUTURE OFFICE ACTIONS AS CORRECT AND PROPER OFFICE ACTIONS**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 223133-1450

Dear Sir:

This paper is being filed in response to the Final Office Action mailed July 3, 2007. The Commissioner is authorized to charge any required fee occasioned by this paper – including any Petition fees – or credit any overpayment in fees to Deposit Account No. 50-0320. The herein Petitions are pursuant to any of the Rules (any section of 37 CFR), including 37 CFR 1.182.

RELIEF REQUESTED

Pursuant to any Rules (37 CFR), including 37 CFR 1.182:

It is respectfully requested that the July 3, 2007 Final Office Action be withdrawn, and that finality also be withdrawn.

It is further respectfully requested there be an Interview with the Examiner at the soonest possible date, prior to the issuance of any further Office Action, with a view towards reaching agreement on allowance of this application.

And it is further respectfully requested that if agreement on allowable subject matter is not met, then all future Office Actions be proper and complete Office Actions.

FACTS & ARGUMENT

Applicants have endured at least three (3) improper and incomplete Office Actions in this application and have endeavored to work through the deficiencies of those Office Actions to no avail. And, when seeking to interview this application during the period of October 2-4, 2007, with representatives of the client from the UK, the Examiner indicated both non-availability and the unwillingness to meet even if available.

More specifically, there was a May 17, 2006 Office Action that had an omnibus double patenting rejection at paragraph 15 that stated: "The double patenting rejections discussed above ... are representative of the vast number of patents and copending applications having overlapping subject matter ... applicant is required to provide the Office with a complete list: Patents: ... 5,616,574; 5,604,215 etc. Copending applications: ... etc."

In response, Applicants indeed provided a list of patents and copending applications.

In the October 25, 2006 Final Office Action, the double patenting rejections at paragraphs 9 and 10 DID NOT employ form paragraph 8.34, and specifically did not identify the particular claims of patents and co-pending applications upon which the double patenting rejections were based. Moreover, the double patenting rejection included an omnibus double patenting rejection based on "patents and application listed in paragraph 15 of the previous Office Action."

In response, Applicants pointed out the deficiencies of the double patenting rejections, as well as that the double patenting rejections were inconsistent with the withdrawal of the Section 103 rejection (*see, e.g.*, May 3, 2007 Supplemental Response).

In reply to the July 3, 2007 Supplemental Response (and April 25, 2007 Amendment), a July 3, 2007 Final Office Action issued. That Final Office Action suffers from similar deficiencies of the May 17, 2006 Office Action and the October 25, 2006 Final Office Action, and has additional deficiencies. In short, it is respectfully asserted that Applicants have received a woefully incomplete Office Action.

For example, in the July 3, 2007 Office Action, the Examiner withdrew the previous double patenting rejection based on US Patents Nos. 5,830,886, 5,616,574 and 5,604,215 based upon the arguments previously presented; but, issued a double patenting rejection based on **unidentified claim or claims** of US Patent No. 6,903,084. The 886 and 574 patents claim a lineage to PCT/GB92/01587, from which WO 93/05064 published.

The Office Action refers to 084 patent claim 1. However, the 084 patent likewise dates itself back to PCT/GB92/01587 from which WO 93/05064 published; and, the 084 patent claim 1 citation by the Examiner in the Office Action is supported by PCT/GB92/01587, published as WO 93/05064. Thus, the reasons for withdrawal of the double patenting rejections based on US Patents Nos. 5,830,886 and 5,616,574 equally apply to the double patenting rejection based on the 084 patent.

That is, to paraphrase the Supplemental Response of May 3, 2007: The standard for overcoming an allegation of obviousness – whether it be by way of a Section 103 rejection or an obviousness-type double patenting rejection – is the same (and obviousness-type double patenting only has statutory basis in 35 USC 103 such that the standard must be the same). Having overcome the former Section 103 rejections, Applicants overcame the double patenting rejection as to the 084 patents, i.e., the data and arguments that the Examiner agrees shows nonobviousness such that the Section 103 rejections are withdrawn (see August 17, 2006 Amendment, pages 13-16), thereby shows nonobviousness to overcome the double patenting rejection as to the 084 patent. And hence the double patenting rejection as to the 084 patent should be reconsidered and withdrawn. For instance, Reed, WO 93/05064, published from PCT/GB92/01587; and the rejection based on Reed was withdrawn in view of the arguments and data previously presented. The double patenting rejection is based on the 084 patent. The 084 patent claims a lineage to PCT/GB92/01587 – the very same document from which W092/05064 was published, such that the 084 patent and Reed W093/05064 have the same disclosure. (Consider pages 4-5 of Reed and the claims of the 084 patent.) Thus, what was fully considered

by the Examiner as having been overcome by the Applicants is that which is relied upon in the double patenting rejection as to the 084 patent. Hence, Applicants have already overcome the double patenting rejection as to the 084 patent.

Thus, the double patenting rejection based on the 084 patent is again inconsistent with the withdrawal of the previous Section 103 rejections and also inconsistent with the withdrawal of previous double patenting rejections, and is therefore improper and should be reconsidered and withdrawn, and such relief is respectfully requested.

Furthermore, the July 3, 2007 Office Action also rejected claims of the pending application for double patenting based on unidentified claims of US Patent No. 7,119,081. The claims of the 081 patent were found patentable over the disclosure of US Patent No. 6,011,024. The present application claims a lineage to the application from which the 024 patent issued. At columns 6-7 the 024 patent contains language supporting the instant claims. Thus, the claims of the 081 patent have been held patentable over the subject matter of the instant application claims. And the claims of the instant application are likewise patentable over the claims of the 081 patent. Note for instance that BOTH R₁ and R₂ are sulphamate groups in the 081 patent claims, *inter alia*, which does not teach or suggest the subject matter of the present claims.

The USPTO is respectfully directed to *In re Braat*, 937 F.2d 589, 19 USPQ2d 1289 (Fed. Cir. 1991). The Federal Circuit there held that, “[o]bviousness-type double patenting is a judicially created doctrine intended to prevent *improper* timewise extension of the patent right by prohibiting the issuance of claims in a second patent which are not ‘patentably distinct’ from the claims of a first patent.” *Id.* at 592. The present situation is akin to the situation in *Braat* in that the 081 patent issued before the present application from an application having a later effective filing date than the present application. That is, the term of the patent to issue from the present application IS SHORTER THAN the term of the 081 patent. Or, phrased differently, the 081 patent has a LONGER TERM than the patent to issue from the present application. Thus, THERE IS NO IMPROPER TIMEWISE EXTENSION – OR ANY TIMEWISE EXTENSION – OF PATENT RIGHTS BY GRANTING THE PRESENT APPLICATION OVER THE 081 PATENT.

In *Braat*, the Federal Circuit held that the double patenting rejection was improper because “applications for basic and improvement patents should not be penalized by the rate of

progress of the applications through the PTO, a matter over which the applicant does not have complete control.” *Id.* at 593.

Therefore, for the reasons of *Braat* and/or for the reason that the claims of the instant application are patentably distinct from the claims of the 081 patent, including as evidenced by the USPTO issuing the 081 patent over the 024 patent, the double patenting rejection based on the 081 patent is improper and should be reconsidered and withdrawn with such relief respectfully requested.

The July 3, 2007 Office Action also rejected claims of the pending application for double patenting based on **unidentified claims of** USSN 10/367,114. This provisional double patenting rejection is simply incomprehensible because the 081 patent issued from USSN 10/367,114. Thus, this double patenting rejection is one that Applicants simply cannot respond to. And it demonstrates the woefully inadequate nature of the July 3, 2007 Final Office Action.

Moreover, the Office Action also rejected claims of the pending application for double patenting based on **unidentified claims of** “patents and applications listed in paragraph 15 of the Office Action dated May 17, 2006”. The rejection based on “patents and applications listed in paragraph 15 of the Office Action dated May 17, 2006” is improper and incomplete, and cannot be addressed and therefore should be reconsidered and withdrawn. In short, Applicants cannot respond to the rejection because it is unclear as to which patents, applications and claims are involved in the double patenting rejection based on **unidentified claims of** “patents and applications listed in paragraph 15 of the Office Action dated May 17, 2006”.

Specifically, APPLICANTS HAVE NOW SUFFERED THROUGH MULTIPLE INCOMPLETE AND IMPROPER OFFICE ACTIONS IN THE PROSECUTION OF THIS APPLICATION. And Applicants respectfully disagree with the form and substance of the double patenting rejections.

A double patenting rejection must identify particular claim or claims of the cited patents or co-pending applications and must identify particular claims of the instant application which are allegedly obvious in view of the particular cited claim or claims of the cited patents or co-pending applications. Consider, for instance, from paragraph 8.34 of the MPEP which directs HOW a double patenting rejection is to be made; that is, by identifying claims of the patent being cited in the double patenting rejection.

The July 3, 2007 Final Office Action is incomplete and improper because it fails to identify particular claims of the 081 and 084 patents and of USSN 10/367,114 in view of which claim or claims of the instant application are allegedly obvious (or vice versa). Again, see, e.g., form paragraph 8.34 of the MPEP which directs HOW a double patenting rejection is to be made; that is, by identifying claims of the patent being cited in the double patenting rejection. Likewise, since USSN 10/367,114 issued as the 081 patent, Applicants cannot respond to the double patenting rejection based on USSN 10/367,114.

Furthermore, the Office Action is also incomplete and improper because it fails to identify fully applications or patents upon which the double patenting rejection is based.

More in particular, the rejection “patents and applications listed in paragraph 15 of the Office Action dated May 17, 2006” is improper and incomplete, and cannot be addressed because it is unclear which applications or patents are being applied in the double patenting rejection.

For example, paragraph 15 of the May 17, 2006 Office Action lists patents as to which the double patenting rejection is affirmatively stated to be withdrawn, e.g., US Patent No. 5,616,574. More in particular, the July 3, 2007 Final Office Action first states that the double patenting rejection is withdrawn as to, *inter alia*, US Patents Nos. 5,616,574 and 5,604,215; but, then states that the claims are rejected based on “patents and applications listed in paragraph 15 of the Office Action dated May 17, 2006”. US Patents Nos. Nos. 5,616,574 and 5,604,215 are listed in paragraph 15 of the May 17, 2006 Office Action. Are the presently pending claims rejected in view of claims of US Patents Nos. Nos. 5,616,574 and 5,604,215; or are they not? And if so, which claim or claims of US Patents Nos. Nos. 5,616,574 and 5,604,215 form the bases for the rejections. And in this regard, which claim or claims of any other patent or application employed in the double patenting rejections form the bases for those rejections? Applicants just do not know as the July 3, 2007 Office Action is SILENT.

Even further still, paragraph 15 of the May 17, 2006 Office Action ends each patent and application listing with “etc.” So, it is UNKNOWN what patents or applications are being applied in the present double patenting rejection. Applicants thus CAN NEVER reply to the present double patenting rejections.

For instance, how can Applicants argue patentability or file a Terminal Disclaimer as to the “etc” patent or the “etc” application??

The double patenting rejections and the July 3, 2007 Final Office Action is woefully incomplete and improper; and, it is respectfully requested that finality therefore be withdrawn, and that the July 3, 2007 Final Office Action itself be withdrawn. Simply, if the Office Action cannot fully set forth rejections, issue has not been met, and both finality and the Office Action itself should be withdrawn.

Moreover, it is respectfully requested that the Examiner engage in an interview in this application with Applicants representatives from the UK, and the undersigned, who are at the USPTO both today and tomorrow, with a view towards placing the application in condition for allowance. Applicants would like to understand the Examiner's positions – as such cannot be divined from the Office Actions – and would like to try to work with the Examiner in reaching agreement on allowable subject matter; but, such cannot occur if the Examiner's position is that she would not engage in an interview if she were available. To advance prosecution, the Examiner should engage in an interview; and such relief is respectfully requested.

Finally, it is respectfully requested that if agreement on allowance is not reached that all future Office Actions be a complete and proper Office Actions as Applicants are entitled to such, at the very least.

CONCLUSION

In view of the facts and arguments herein, the July 3, 2007 Final Office Action should be withdrawn, and that finality also should be withdrawn. And such relief is respectfully requested. Moreover, there be an Interview with the Examiner at the soonest possible date, prior to the issuance of any further Office Action, with a view towards reaching agreement on allowance of this application. And such relief is respectfully requested. And it is further respectfully requested that if agreement on allowable subject matter is not met, then all future Office Actions be proper and complete Office Actions.

Respectfully submitted,
FROMMER LAWRENCE & HAUG LLP

By Thomas J. Kowalski
Thomas J. Kowalski
Reg. No. 32,147
Angela M. Collison
Reg. No. 51,107
(212) 588-0800